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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 128410-2 (MHM 13865US02))

PATENT APPLICATION OF:

Anderson et al.

SERIAL NO.: 10/713,514

FILED: November 14, 2003

FOR: Magnetic Tracking System

Art Unit: 2863

Examiner: Le, John H.

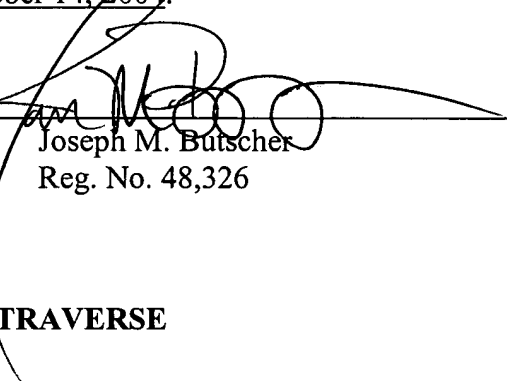
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) By: 
) Joseph M. Butscher
) Reg. No. 48,326

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ELECTION WITH TRAVERSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Paper responds to the Office Action mailed October 4, 2004. This response is timely because it is being filed within the period set for response.

ELECTION

The Examiner indicated that the Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Applicants provisionally elect *with* traverse Species 2, which relates to claims 12, and 20-22. The Applicants request that the Examiner reconsider this restriction requirement and withdraw it for the reasons discussed below.

TRAVERSAL

The restriction requirement is respectfully traversed because “if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP Section 803. Thus, even if the inventions are independent or distinct, restriction is improper if the search and examination of the entire application can be made without serious burden.

One of the “two criteria for a proper requirement for restriction between patentably distinct inventions” is that “[t]here must be a *serious* burden on the examiner if restriction is not required...” *See id.* (emphasis added). While “[f]or purposes of the initial requirement a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search... [t]hat prima facie showing may be rebutted by appropriate showings or evidence by the applicant.” *Id.*

Initially, the Applicant notes that all the claims in the present application are drawn to tracking systems. In fact, four out of the six species have the exact same classification, namely class 600, subclass 427. As such, the Applicants respectfully submit that the initial requirement of a serious burden has not been prima facie shown, at least with respect to these four species.

The Applicant respectfully submits that the search and examination of all of the pending claims can be made without serious burden to the Examiner. The listed categories are closely intertwined. That is, each is related to tracking systems, and particularly to tracking systems that sense attributes of a magnetic field. In general, the Applicants respectfully submit that the Examiner can search all invention categories without serious burden.

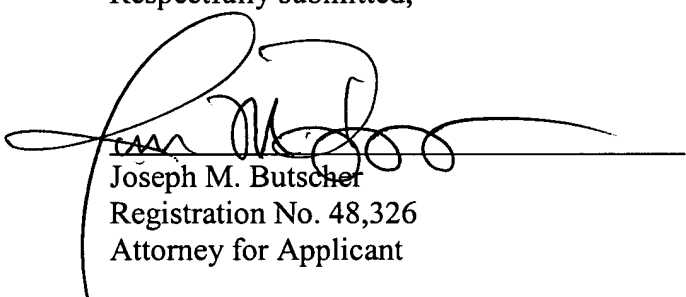
As noted above, “[f]or purposes of the initial requirement a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate

classification, separate status in the art, or a different field of search.” MPEP Section 803. In this case, the Applicant respectfully submits that a prima face serious burden has not been demonstrated by the Examiner. As noted above, four of the six species have the exact same classification. As such, “separate classification” has not been shown, at least with respect to four out of the six species. Next, it has not demonstrated that the categories have a “separate status in the art,” nor a “different field of search.”

The Applicant respectfully submits that the present restriction requirement is improper because the search and examination of the claims of the application can be made without serious burden. Therefore, the Applicant respectfully requests the Examiner to withdraw the restriction requirement.

Respectfully submitted,

Dated: October 14, 2004



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